

Notice of Allowability

Application No.

10/524,978

Examiner

Joseph Kosack

Applicant(s)

FOOTE ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Response to Restriction filed on February 16, 2006.
2. ☒ The allowed claim(s) is/are 1,2,4,8-11 and 13-23.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 2/18/05 & 8/31/05
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

DETAILED ACTION

Claims 1-2, 4, 8-11, and 13-23 are pending in the instant application.

Amendments

The amendment filed on February 16, 2006 has been acknowledged and has been entered into the record. Claims 1-2, 4, 8-11, and 13-23 are now pending in the instant application.

Election/Restrictions

Applicant's election without traverse of the compounds of Example 1 in the reply filed on February 16, 2006 is acknowledged.

Priority

The claim to priority as a 35 U.S.C. 371 filing of PCT/GB03/03631 filed on August 19, 2003, which claims priority to EPO 02292074.8 filed on August 21, 2002, has been acknowledged in the instant application.

Information Disclosure Statement

The Information Disclosure Statements filed on February 18, 2005 and August 31, 2006 have been considered fully by the Examiner.

Double Patenting

The following rejection was communicated telephonically to Lucy Padgett on March 15, 2006.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

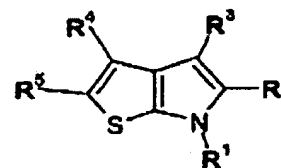
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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

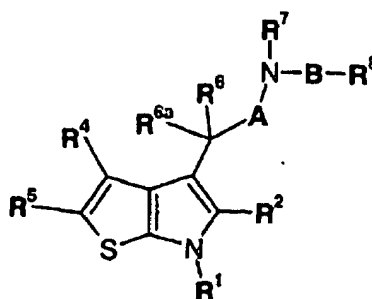
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/525,109, now US PG-PUB 20060004053 A1.



The instant application claims compounds of Formula I:

with substitutions as defined.



'109 teaches compounds of Formula I:

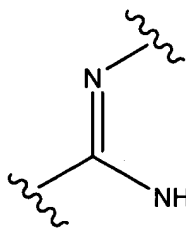
with

substitutions as defined.

'109 does not teach all of the compounds claimed by the instant application.

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'109 does teach some of the compounds claimed by the instant application when



A is a direct bond, B is ; R^1 , R^4 , R^6 , R^{6a} , R^7 , R^8 are hydrogen, R^2 is an optionally substituted bi-cyclic aromatic ring, and R^5 is $C(O)H$.

Therefore, the compounds of '109 are obvious variants of the compounds of the instant application since '109 teaches some of the variations of the instant application's compounds. Hence, '109 suggests the instant invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Terminal Disclaimer

The terminal disclaimer filed on March 15, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Serial Number 10/525,109 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Withdrawal of Double Patenting Rejections

The rejection of Claim 1 for obviousness double patenting over US Serial Number 10/525,109 has been obviated by the filing of and approval of a terminal disclaimer and is hereby withdrawn.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changed and/or additions be unacceptable to applicant, an amendment may be filed as provided

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by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Lucy Padget on March 15, 2006. The application has been amended as follows:

Please amend the title to read: 6H-thieno[2,3-b]pyrrole Derivatives as Antagonists of Gonadotropin Releasing Hormone (GnRH).

In claim 4, line 1, delete "3", and insert ---1---.

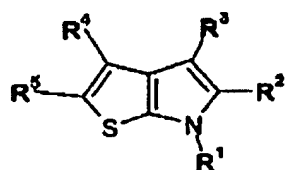
In claim 8, line 1, delete "3", and insert ---1---.

In claim 14, line 1, delete "and/or preventing".

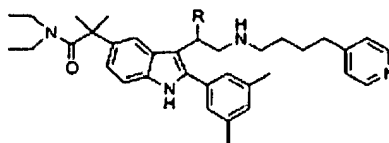
In claim 14, line 2, insert after 'a patient', ---selected from the group consisting of prostate cancer and pre-menopausal breast cancer---.

Reasons for Allowance

The present invention is directed to compounds of Formula I:



, with substitutions as defined, a method of preparation, and their methods of use for treating prostate cancer and pre-menopausal breast cancer. The



closest prior art teaches a compound:

with R being

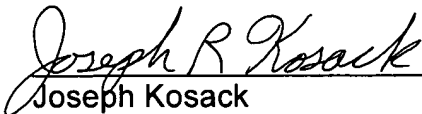
methyl, which has a different core bicycle than the instant invention. Therefore, Claims 1-2, 4, 8-11, and 13-23 are allowed. The restriction requirement made on January 23, 2006 is hereby withdrawn.

Telephone Inquiry


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Kosack whose telephone number is (571)-272-5575. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M^cKane can be reached on (571)-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Joseph Kosack
Patent Examiner
Art Unit 1626

Joseph K. M^cKane
Supervisory Patent Examiner
Art Unit 1626


GOLAM M. M. SHAMEEM, PH.D
PRIMARY EXAMINER